

REMARKS

Applicant hereby adds new claims 21-26. Accordingly, claims 1-26 are pending in the present application.

Claims 1-20 stand rejected under 35 USC 102(e) for anticipation over U.S. Patent No. 6,631,247 to Motoyama et al.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131, which states that "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM." This MPEP section further states that "'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

Referring to claim 1, the device comprises an interface configured to receive a first message including a *first designation identifying an imaging consumable* and processing circuitry configured to convert the first designation to a second designation and to forward a second message including the second designation to the interface for communication to an entity for assisting with replenishment of the imaging consumable.

The Office Action relies upon teachings in Figs. 5, 11, 12, and 13, and cols. 3,13-14, and 21 of Motoyama as allegedly disclosing the limitations of claim 1. The reliance is misplaced inasmuch as *Motoyama fails to disclose or suggest any conversion of a designation which identifies an imaging consumable from a first designation to a second designation as positively-claimed.* In particular, col. 21 at lines 30-45 of Motoyama merely discloses that a device information data structure may include paper jam information, total number of jobs which were performed, s total number of pages printed and other information regarding job imaging. Col. 21, lines 55-65 provide that a service machine may receive email messages and notify

an appropriate entity that a problem exists. Cols. 13-14 merely provide that printers 602 and 604 are monitored by service center 502 and summary information is transferred to a resource administration station. Col. 14, lines 54-634 provide that network devices transmit messages to center 502 which may be a central servicing center of a large corporation while a resource administrator may be an entity for managing local resources for an intranet. In another embodiment, the resource administrator may be a home computer user.

The *teachings of Motoyama* are void of any conversion of designation which identifies an imaging consumable from a first designation to a second designation as claimed. The teachings identified in Action merely disclose communication of messages with absolutely no disclosure or suggestion of the claimed conversion. Page 2 of the Action recites "an email message identifying consumable information of a plurality of network devices." Applicant submits that the mere recitation of identification of a consumable fails to disclose or suggest any conversion including the positively-claimed conversion from the first designation to the second designation identifying the imaging consumable. Applicant has electronically searched the Motoyama reference and have failed to uncover any teachings or suggestion of the claimed conversion. Accordingly, positively-recited limitations of claim 1 are not taught nor suggested by the prior art. In view of at least the above authority, claim 1 recites patentable subject matter for at least this reason and Applicant respectfully requests allowance of claim 1 in the next Action.

In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicant respectfully requests identification in a non-final action of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicant, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicant respectfully requests clarification of the rejections with respect to specific references and specific

references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable. In particular, if claim 1 is not allowed, Applicant requests identification of the specific reference teachings by component reference numbers and column and line numbers of the teachings considered to disclose the claimed conversion so Applicant may appropriately respond during the prosecution of the present application.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to dependent claim 2, *the second message comprises a list including plural second designations converted from plural first designations for a plurality of imaging consumables*. On page 2 of the Action, the Examiner relies upon the teachings of Figs. 25-27 as allegedly disclosing the claimed list. However, Fig. 25 merely provides device information communicated from a single device as stated at col. 21, lines 9-11. Fig. 26 discloses a log containing the identification of a single machine as set forth in col. 22, lines 1-2. Fig. 27 is void of plural designations of imaging consumables as positively claimed. Limitations of claim 2 are not disclosed nor suggested by the prior art and claim 2 is allowable for this additional reason.

If claim 2 is not allowed in the next Action, Applicant requests identification of specific reference teachings which allegedly disclose the limitations of claim 2 in a non-final Action so Applicant may appropriately respond during the prosecution of this application.

Referring to dependent claim 5, the Action at page 3 recites Fig. 25 as allegedly disclosing limitations of claim 5 stating that the *processing circuitry is configured to convert the first designation comprising a manufacturer part number to the second designation comprising a customer part number*. Fig. 25 is void of any disclosure of manufacturer or customer part number teachings. Applicant has electronically searched Motoyama and has failed to uncover any manufacturer or customer part number teachings. Accordingly, claim 5 recites limitations which are not shown nor suggested by the prior art and claim 5 is allowable for this reason.

If claim 5 is not allowed in the next Action, Applicant requests identification of specific reference teachings which allegedly disclose the limitations of claim 5 in a non-final Action so Applicant may appropriately respond during the prosecution of this application.

Referring to dependent claim 6, the device recites that the *storage circuitry is configured to store a look-up table and the processing circuitry is configured to access the look-up table to convert the first designation to the second designation*. The office on page 3 of the Action relies upon the generic RAM teachings of col. 8, lines 20-35 as allegedly disclosing the claimed look-up table. However, the identified teachings are devoid of any look-up table teachings. The mere disclosure of RAM fails to disclose or suggest any look-up table teachings configured or accessed as defined in claim 6. Further, Applicant has electronically searched Motoyama and has failed to uncover any look-up table teachings. Positively-recited limitations of claim 6 are not disclosed nor suggested by the prior art and claim 6 is allowable for at least this reason.

If claim 6 is not allowed in the next Action, Applicant requests identification of specific reference teachings which allegedly disclose the limitations of claim 6 in a non-final Action so Applicant may appropriately respond during the prosecution of this application.

Referring to independent claim 9, the system comprises an *image forming device configured to generate a first message including a first designation identifying an imaging consumable and a consumable management device configured to receive the first message, to convert the first designation to a second designation identifying the imaging consumable, and to communicate the second message to an entity for assisting with replenishment of the consumable*.

The Office at page 4 relies upon the rationale presented with respect to the rejection of claim 1 in support of the rejection of claim 9. However, the teachings identified by the Office fail to disclose or suggest any conversion of a designation which identifies an imaging consumable from a first designation to a second designation. Applicant has electronically searched and failed to uncover any conversion teachings let alone the claimed conversion of the designation. Positively-recited limitations of claim 9 are not disclosed nor suggested by the art and claim 9 is allowable for at least this reason.

If claim 9 is not allowed in the next Action, Applicant requests identification of specific reference teachings which allegedly disclose the limitations of claim 9 in a non-final Action so Applicant may appropriately respond during the prosecution of this application.

The claims which depend from independent claim 9 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 14, Motoyama fails to disclose or suggest *receiving a first message including a first designation identifying an imaging consumable, converting the first designation to a second designation identifying the imaging consumable, or generating and communicating the second message including the second designation*. The teachings relied upon in support of the rejection of claim 14 fail to recite positively-recited limitations of claim 14 including the claimed converting and Applicant has electronically searched Motoyama and has failed to uncover any teachings regarding the claimed converting. Limitations of claim 14 are not disclosed nor suggested by the prior art and the Office has failed to establish a proper 102 rejection. Claim 14 is allowable for at least this reason.

If claim 14 is not allowed in the next Action, Applicant requests identification of specific reference teachings which allegedly disclose the limitations of claim 14 in a non-final Action so Applicant may appropriately respond during the prosecution of this application.

The claims which depend from independent claim 14 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicant hereby adds new claims 21-26 which are supported at least by teachings at least at pages 11-12 of the specification of the originally filed application.

Allowance of the new claims is respectfully requested.

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is

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Amendment A

available for telephone consultation at any time during normal business hours
(Pacific Time Zone).

Respectfully submitted,

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